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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/559,804	12/07/2005	Christof Maisch	LA-7688-102/10512640	1047

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FULBRIGHT AND JAWORSKI LLP  
555 S. FLOWER STREET, 41ST FLOOR  
LOS ANGELES, CA 90071

EXAMINER
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WENDELL, MARK R

ART UNIT	PAPER NUMBER
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3635

MAIL DATE	DELIVERY MODE
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12/26/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/559,804	<b>Applicant(s)</b> MAISCH ET AL.	
	<b>Examiner</b> Mark R. Wendell	<b>Art Unit</b> 3635	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 December 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>20051207</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Priority***

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. DE 10326333, filed on June 11, 2003.

### ***Drawings***

The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81(c). No new matter may be introduced in the required drawing. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). The drawings from the PCT application are being used for examination purposes.

New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because there are numerous handwritten marks and the drawings are of insufficient quality to discern the exact features of the invention. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the reinforcement elements must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3, 9 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 3, the phrase "part region" is not defined in the specification or labeled in the drawings. Language within the claim is necessary, without adding new matter, for a full understanding to what a "part region" is.

Regarding claims 9 and 12, the claims iterate multiple ranges within the description which fails to particularly point out and distinctly claim the actual dimension of the objects.

Claim 15 provides for the use of top chord, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 15 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition

of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8, 10-11, 13-18, 21-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Chicago (WO 97/12101). Regarding claims 1 and 2, Chicago illustrates in Figure 2 a profile rail comprising:

- A base body (entire structure) that is formed at least regionally as a T section and that includes an elongate web (2') as well as a bottom chord (11), which is arranged along a longitudinal edge of the web (2') and includes two bottom chord sections (11 which protrude on opposite sides), each of which extend from the web (2') substantially in opposite directions, the web being provided with a screening strip (bottom edge of elongate strip on the bottom of the structure), wherein a plurality of apertures (7) are formed in the web (2'), and the web (2') is essentially made in one layer over its total area.

In regards to the claimed limitations: "with the bottom chord (11) being formed by a bent-over portion of the web (29) and the side of the bottom chord (28) disposed remote from" and "at least one of the bottom chord sections (26) is formed by material sections (23) of the web (29) folded out of the apertures (30)" along with all of claim 2, the statements reflect product by process limitations. MPEP 2113 states, "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process."

Regarding claim 3, Chicago illustrates in Figure 2 both bottom chord sections (11) respectively alternating formed regionally by material sections of the web (2') folded out of the apertures (7) and by one-piece bent-over portions of the web adjoining them, with each part region of the one bottom chord section (10, 11) formed as a one-piece bent-over section lying opposite to a part region of the other bottom chord section (11) formed by material sections folded out of the apertures (7).

Regarding claim 4, Chicago illustrates in Figure 2 the apertures (7) having a straight edge (top of the aperture) extending parallel to the longitudinal edge of the web (2').

Regarding claim 5, Chicago illustrates in Figure 2 the apertures (7) being trapezoidal in shape.

Regarding claims 6 and 7, Chicago illustrates in Figure 2 the opposite bottom chords (11) extending substantially parallel to one another and having substantially the same width.

Regarding claim 8, Chicago illustrates in Figure 2 the web (2') and the chords (11) being substantially perpendicular to one another.

Regarding claim 10, Chicago discloses on page 1, lines 13-15 and in Figure 2 the base body (entire structure) produced from a uniform strip of metal.

Regarding claim 11, Chicago illustrates in Figure 2 the web (2') being substantially flat.

Regarding claim 13, Chicago illustrates in Figure 2 that the screening strip is affixed to the bottom chords (11) via engaging. The examiner notes that all three methods (rolling, adhering, or laminating) are all well-known methods of affixing the screening strip to the chords.

Regarding claims 14 and 15, Chicago illustrates in Figure 2 a top chord (folded portion on the top of the structure) provided at the longitudinal edge (top) of the web (2') opposite the bottom chords (11).



Regarding claim 16, Chicago illustrates in Figure 2 the top chord made as a hollow section.

Regarding claim 17, Chicago illustrates in Figures 2 and 3 the top chord made in corresponding manner to the bottom chords (11).

Regarding claim 18, Chicago illustrates in Figure 2 the top chords connected to the web (2').

Regarding claims 21 and 22, Chicago illustrates in Figure 2 the apertures (7) having substantially the same width in the longitudinal direction of the web (2') and the material sections of the web (9 and 10).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9, 12, 19, 26-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chicago (WO 97/12101). It is described above what is disclosed by Chicago, however Chicago does not distinctly give measurements for the radius of the bent-over portion or

the thickness of the web and chords. The applicant fails to provide criticality for the distinct measurements given within the claims and it would have been obvious to one having ordinary skill in the art at the time of invention to have the specific measurements for the radius, web and chord since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art (In re Boesch, 617 F. 2d 272, 205 USPQ 215). The examiner also notes that the variability of the actual specific measurement values within the claim lends credence to the fact that the specific dimensions are in fact critical to the viability of the invention.

Regarding claim 19, Chicago does not distinctly claim the top chord being connected to the web via stitching. However, the web (2') and top chord are connected. Various method of attaching metal objects together are well known within the art including stitching, which is generally done with wire staples.

Regarding claims 26-32, given the structure of Chicago described above, the claimed method step would have been obvious. The examiner notes that the method steps of providing a piece of metal, forming and bending a shape, and making incisions, via rotation cutting or laser cutting, into the metal for folding purposes is well-known in the art of metal working.

Claims 20, 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chicago (WO 97/12101) in view of LaLonde et al. (US 5761868). It is described above

what is disclosed by Chicago, however regarding claims 20 and 23 Chicago does not teach additional fastening apertures, or reinforcement beads, formed in the web.

LaLonde illustrates in Figure 1 additional fastening apertures (18). Both Chicago and LaLonde refer to profile connector rails and it would have been obvious to one having ordinary skill in the art at the time of invention to include additional apertures, or reinforcement beads in between the apertures, in the web of Chicago in order to facilitate more interconnecting support members or utilities.

Regarding claim 25, neither Chicago not LaLonde teach reinforcement elements disposed between two apertures in the web. However, it would have been obvious to one having ordinary skill in the art at the time of invention to have additional reinforcement elements or beads between two apertures in the web since it has been held that rearranging parts of an invention (without compromising the structural integrity) involves only routine skill in the art (In re Japikse, 86 USPQ 70). The examiner further notes that adding additional apertures or beads would be obvious based on the size of the rail that is necessary.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark R. Wendell whose telephone number is (571) 270-3245. The examiner can normally be reached on Mon-Fri, 7:30AM-5PM, Alt. Fri off, EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (571) 272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Richard Chilcot  
Supervisory Patent Examiner  
Art Unit 3635

MRW  
December 13, 2007

10/559804

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Application No. (if known): Not Yet Assigned

Attorney Docket No.: LA-7688-102US

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IDS (Citation) by Applicant (1 page)  
Information Disclosure Statement